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| 22434 | 7590 | 10/31/2006 | EXAMINER | |
| BEYER WEAVER & THOMAS, LLP | | | LE, MIRANDA | |
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2167

DATE MAILED: 10/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/799,412

Applicant(s)

JAWA ET AL.

Examiner

Miranda Le

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 03/03/05, 12/23/04, 10/07/04.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 USC 121:

Group I: Claims 1-16 drawn to a method of retrieving digital media, classified in Class 707, subclass 3.

Group II, Claims 17-22, drawn to a method of providing media, classified in Class 707, subclass 104.1.

An oral election was made with traverse of Group I, claims 1-16 by Mr. C. Douglass Thomas on October 24, 2006. Group II, claims 17-22, are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected.

Preliminary Amendment

2. Applicant's Preliminary Amendment, filed 10/07/04, has been received, entered into the record, and considered.

Information Disclosure Statement

3. Applicants' Information Disclosure Statements, filed 03/03/05, 12/23/04, 10/07/04, has been received, entered into the record, and considered. See attached form PTO-1449.

Claim Objections

4. Claim 3 is objected to because of the following informalities: Claim 3 is ended with a semicolon (;), which should be changed to a period (.). Appropriate correction is required.

Claim 13 is objected to because of the following informalities: Claim 13, line 4, the phrase “wherein the processor is operable to perform instruction including” should be read either as a) “wherein the processor is capable of executing instruction to perform steps including”; or b) wherein the processor is capable of carrying out operations including”. Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-12 define non-statutory processes because as a whole, they merely present an abstract idea without any practical application that produces a useful, concrete and tangible result.

The claimed processes, “querying...; receiving...; requesting...” manipulate abstract ideas to result in an abstract construct (no tangible result), and fail to adequately reflect the described practical utility (no useful result). The last step of these claims recites receiving/requesting step; the claims fail to recite tangible results, as the receiving/requesting step is not tangible. While retrieving digital media could reasonably be considered a tangible result, the body of claims 1, 8 do not appear to actually support the preamble by including a step or steps which accomplish that act.

Claims 2-7 and 9-12 incorporate the deficiencies of claims 1, 8 and do not add tangibility to the claimed subject matter, they are likewise rejected.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless:

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-13, 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Rolf (US Patent No. 7,065,342).

Rolf anticipated independent claims 1, 8, 13 by the following:

As per claim 1, Rolf teaches a method of retrieving digital comprising:

querying a server for features of the server (*i.e. the user may select one or more recordings for streaming, col. 2, line 53 to col. 3, line 16*) (*col. 1, lines 25-38; col. 5, lines 15-59*);

receiving the features of the server, the features including information about at least one digital media database, wherein information about the at least one digital media database includes metadata about records, the records pertaining to digital media metadata or media collection data or both (*i.e. the artist, title of the recording, an album from which the recording came, col. 2, line 53 to col. 3, line 16*) (*col. 1, lines 25-38; col. 5, lines 15-59*);

querying the server for information required to populate the records associated with the metadata (*i.e. the user having a choice of whether to buy the single being played, or the entire album on which the single is located, col. 7, lines 8-18*);

receiving the information required to populate the records associated with the metadata (*i.e. the user also has the opportunity to select the manner in which the purchased recording or album will be distributed to the user, col. 7, lines 8-18*).

As per claim 8, Rolf teaches a method of retrieving media comprising:

connecting to a server, the server including media information (*i.e. a wireless communication link, col. 1, lines 25-38*);

querying the server for at least a portion of the media information (*i.e. the user may select one or more recordings for streaming, col. 2, line 53 to col. 3, line 16*) (*col. 1, lines 25-38; col. 5, lines 15-59*);

receiving metadata responsive to the query, at least one metadata item being associated with media or a media collection (*i.e. the artist, title of the recording, an album from which the recording came, col. 2, line 53 to col. 3, line 16*), (*col. 1, lines 25-38; col. 5, lines 15-59*); and

requesting information to which the at least one metadata item is associated with (*i.e. the user having a choice of whether to buy the single being played, or the entire album on which the single is located, col. 7, lines 8-18*).

As per claim 13, Rolf teaches a computing device comprising:

a processor (*Fig. 4*);

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memory, operably connected with the processor (*Fig. 4*);

wherein the processor is operable to perform instruction including (*Fig. 4*):

connecting to a server, the server including media information (*i.e. a wireless communication link, col. 1, lines 25-38*);

querying the server for at least a portion of the media information (*i.e. the user may select one or more recordings for streaming, col. 2, line 53 to col. 3, line 16*), (*col. 1, lines 25-38; col. 5, lines 15-59*);

receiving media information responsive to the query (*i.e. the artist, title of the recording, an album from which the recording came, col. 2, line 53 to col. 3, line 16*), (*col. 1, lines 25-38; col. 5, lines 15-59*);

requesting at least one media item associated with the media information responsive to the query (*i.e. the user having a choice of whether to buy the single being played, or the entire album on which the single is located, col. 7, lines 8-18*);

receiving the media item (*i.e. the purchased recording or album may be downloaded to the wireless communications device 12, col. 7, lines 8-18*).

As per claim 2, Rolf teaches the records to both digital media metadata and media collections and multiple queries are required to populate the records associated with the metadata (*col. 6, line 42 to col. 7, line 23; col. 11, line 45 to col. 12, line 16*).

As per claim 3, Rolf teaches using a local database management system to manage the information contained in the media collection data records and the digital media metadata records (*col. 7, line 49 to col. 8, line 53*).

As to claims 4, 12, Rolf teaches the server is a remote device across a network (*col. 1, lines 25-38*).

As per claim 5, Rolf teaches requesting media from across a network; and receiving the requested media (*col. 1, lines 25-38*).

As per claim 6, Rolf teaches presenting the received media at a client device, wherein presenting the received media includes playing the media for a user (*col. 6, line 42 to col. 7, line 23; col. 11, line 45 to col. 12, line 16*).

As per claim 7, Rolf teaches the method is stored as instructions on a computer-readable medium (*col. 6, line 42 to col. 7, line 23; col. 11, line 45 to col. 12, line 16*).

As per claim 9, Rolf teaches the method is performed by a client-side media management system (*col. 6, line 42 to col. 7, line 23; col. 11, line 45 to col. 12, line 16*).

the query indicated the portion (*col. 2, line 53 to col. 3, line 16*); and

the portion is at least partially based upon whether the client-side media management system had limited user interface abilities (*col. 8, line 6-31*).

As per claim 10, Rolf teaches the method is performed by a client-side media management system (*col. 6, line 42 to col. 7, line 23; col. 11, line 45 to col. 12, line 16*); the query indicated the portion (*col. 2, line 53 to col. 3, line 16*); the portion is at least partially based upon whether the client-side media management system has a limit memory, whereby the limited memory is not sufficient to store all the media information available from the server (*col. 8, line 6-31*).

As per claim 11, Rolf teaches the query indicated the portion (*col. 2, line 53 to col. 3, line 16*); and the portion is at least partially based upon providing a user with a customized experience (*col. 7, lines 24-43; col. 9, line 43 to col. 10, line 3*).

As per claim 15, Rolf teaches the processor is further operable to perform instruction including: querying the server for database enumeration (*col. 8, line 6-31*); and receiving a response to the database enumeration query that describes at least one database, the description including how much media is available from the at least one database or how many media collection are available from the at least one database or both (*col. 8, lines 32-53*).

As per claim 16, Rolf teaches querying the server for at least a portion of the media information is a request for an enumeration of at least a portion of media collections (*col. 8, line 6-31*).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rolf (US Patent No. 7,065,342), in view of Kim (US Pub. No. 20040214551).

As per claim 14, Rolf does not explicitly teach the processor is further operable to perform instruction including: querying the server for server capabilities; receiving a response to the server capabilities query that describes the server.

However, Kim teaches querying the server for server capabilities; receiving a response to the server capabilities query that describes the server (*i.e. searches, [0034]*).

It would have been obvious to one of ordinary skill of the art having the teaching of Rolf and Kim at the time the invention was made to modify the system of Rolf to include querying the

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server for server capabilities; receiving a response to the server capabilities query that describes the server as taught by Kim.

One of ordinary skill in the art would be motivated to make this combination in order to select desirable multimedia data contents and requests the selected contents to be downloaded in view of Kim, as doing so would give the added benefit of providing an integrated multimedia data format suitable for use in multimedia communication environment.

Conclusion


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham, can be reached on (571) 272-7079. The fax number to this Art Unit is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Miranda Le
October 24, 2006



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